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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,692	03/11/2004	Mark W. Becker	249.PIC2	6194

7590

05/18/2005

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EXAMINER

LEARY, LOUISE N

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,692

Applicant(s)

BECKER ET AL.

Examiner

Louise N. Leary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 9-17-2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 35-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-17-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 34-41 are pending in this application.

Claims 1-33 have been canceled per applicant's request in the Preliminary Amendment filed September 17, 2004.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 36 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 23 of copending Application No. 10/354207. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 does not end with a period. It is suggested that a period be added after "solvates".

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Claim 37 is indefinite because the claim is unclear regarding which compound structure is represented by "(7)" and "(7a)". Also, claim 37 does not end with a period.

Claims 38-40 are indefinite because claim 38 depends to cancelled "claims 1-4".

Correction is required to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(A) Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/031228. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions claim compounds that can be identical. Specifically, the compound structure identified as (5a) in the instant

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application is identical to the compound structure identified as (1a) in copending Application No. 11/031228. Likewise, the compound structure identified as (5b) in the instant application is identical to the compound structure identified as (1b) in copending Application No. 11/031228. Hence, both inventions selectively claim the same compounds. Thus, there is substantial overlap of the subject matter claimed in both inventions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(B) Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/031250. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions claim compounds that can be identical. Specifically, the compound structure identified as (5a) in the instant application is identical to the compound structure identified as (1a) in copending Application No. 11/031250. Likewise, the compound structure identified as (5b) in the instant application is identical to the compound structure identified as (1b) in copending Application No. 11/031250. Hence, both inventions selectively claim the same compounds. Thus, there is substantial overlap of the subject matter claimed in both inventions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(C) Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/031251. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions claim compounds that can be identical. Specifically, the compound structure identified as (5a) in the instant application is identical to the compound structure identified as (1a) in copending Application No. 11/031251. Likewise, the compound structure identified as (5b) in the instant application is identical to the compound structure identified as (1b) in copending Application No. 11/031251. Hence, both inventions selectively claim the same compounds. Thus, there is substantial overlap of the subject matter claimed in both inventions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(D) Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/031252. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions claim compounds that can be identical. Specifically, the compound structure identified as (5a) in the instant application is identical to the compound structure identified as (1a) in copending Application No. 11/031252. Likewise, the compound structure identified as (5b) in the

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instant application is identical to the compound structure identified as (Ib) in copending Application No. 11/031252. Hence, both inventions selectively claim the same compounds. Thus, there is substantial overlap of the subject matter claimed in both inventions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 34 is allowable over the prior art of record.

6. The WO 2002008241 A2 reference has been cited to further show the state of this art.

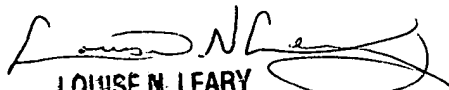
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise N. Leary whose telephone number is 571-272-0966. The examiner can normally be reached on Monday to Friday from 10 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campbell, can be reached on 571-272-0966. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LOUISE N. LEARY
PRIMARY EXAMINER

May 16, 2005